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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,670	01/22/2004	Steven T. Schlonski	D/A3014	5160
7590 01/10/2007 Patent Documentation Center Xerox Corporation Xerox Square 20th Floor 100 Clinton Ave S. Rochester, NY 14644			EXAMINER CHEN, ALAN S	
			ART UNIT 2182	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/762,670	SCHLONSKI ET AL.	
	Examiner	Art Unit	
	Alan S. Chen	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-13 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/22/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-7 are rejected under 35 USC 103(a) as being unpatentable over Merriam in view of Applicant's Admitted Prior Art (AAPA).

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5. Per claim 1, Merriam discloses a method (*Fig. 5*) of communicating between a computer (*various elements on the network all have processors and therefore can be construed as being printer, e.g., elements 102-110*) and a digital printer (*Fig. 1, element 108*) having a network address associated therewith (*Column 3, lines 60-65, printer has a network address corresponding to it*), comprising: attempting communication to the network address (*Fig. 5, steps 504+ all attempt to establish communication with the device represented by the network address*). Merriam discloses that simply by having the IP address, one can establish communication with the printer based on matching the IP address to an address in a table or if the address is not in the table, adding the address to the table (*Column 5, lines 15+, Column 7, lines 20+*). The IP address is linked to information of the device in the table or another repository. It is intrinsic to Merriam that the table is searched sequentially based on the IP address table listing (*Fig. 4*), e.g., line by line on the table. Note, Merriam does not need to use LPR protocol since he strictly uses network protocol TCP/IP and thus the conditional limitations in the claims of the instant application are false and are unnecessary to Merriam.

Merriam does not disclose expressly sequentially using a plurality of port numbers in order to communicate with the printer device.

AAPA discloses RAW printer ports (*which is precisely what Merriam uses since he uses the Internet Protocol*) have various known port numbers (*page 2, lines 10-15, 9100, 2000 or 2105*).

Merriam and AAPA are analogous art because they are from the same field of endeavor in establishing communication with a network printer when a previous unknown device is introduced to a network.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to sequentially find the port number that the at which the printer operates.

The suggestion/motivation for doing so would have been that the device parameters may not be listed in the table of Fig. 4 of Merriam or the other device attribute repositories in Merriam and since there is a fixed and discrete amount of port numbers, it would have been obvious at the time of the invention to cycle through them to determine which port number the printer operates at.

6. Per claim 2, Merriam combined with AAPA discloses claim 1, Merriam further disclosing determining the network address of the digital printer (*Fig. 4 and Fig. 5, element 504*).

7. Per claim 3, Merriam combined with AAPA discloses claim 2, Merriam further discloses entering the network address of the digital printer (*Column 10, lines 5-15, address added to table when it is a new device that was not previous in the table*).

8. Per claim 4, Merriam combined with AAPA discloses claim 2, Merriam further discloses discovering the network address of the digital printer (*Fig. 5, element 504, packet containing address of printer is discovered*).

9. Per claim 5-6, Merriam combined with AAPA discloses claim 1, Merriam combined with AAPA operates only using TCP/IP and therefore doesn't need LPR port numbers.

10. Per claim 7, Merriam combined with AAPA discloses claim 7, wherein the computer includes a digital camera (*Fig. 1, element 104*).

Allowable Subject Matter

11. Claims 8-13 are allowed.

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The following is the statement of reasons for the indication of allowable subject matter:

The prior art disclosed by the applicant and cited by the Examiner fail to teach or suggest, alone or in combination, *all* the limitations of the independent claim(s) (claim 8), particularly a computer for communicating with a digital printer having a network address associated therewith, comprising: means for attempting communication to the network address, sequentially using each of a plurality of port numbers; and means for attempting communication to the network address using an LPR port number, *sequentially using each of a plurality of LPR queue names*.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Patents and patent related publications are cited in the Notice of References Cited (Form PTO-892) attached to this action to further show the state of the art with respect to automatically detecting and configuring digital printer using LPR or RAW communication protocols.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASC
1/4/2007



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